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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application No. 78/215,335

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For: **VIDEO POD**

APPLE INC.,

Opposer,

vs.

SECTOR LABS, LLC,

Applicant.

Opposition No. 91176027

OPPOSER'S TRIAL BRIEF

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I. SUMMARY OF ARGUMENT

On October 23, 2001, Apple, the world famous technology company, introduced a portable music player that Apple branded the IPOD. Apple's IPOD music player was an immediate commercial and critical success. It quickly revolutionized the consumer electronics industry and fundamentally changed the manner in which music and video and other forms of media content are distributed and displayed to consumers in the U.S. and worldwide. As of September 2010, approximately 250 million IPOD media players had been sold and Apple has enjoyed net sales revenue from sales of the IPOD product of over \$1 billion for each year from 2004 through the present. As a result of Apple's extensive advertising and sales, and the phenomenal success of the IPOD product, Apple's IPOD mark has undoubtedly become one of the most well-known and valuable trademarks in the world.

After launching the IPOD music player in 2001, Apple quickly expanded the capabilities of the device to include storage and display of photos and video among a host of other functionalities. In the approximately ten years since the product was first introduced, Apple has released new generations of IPOD media players, with enhanced and varying features and price points to attract the widest consumer base. Apple has also developed and released many accessories compatible with the product, and has licensed use of the IPOD mark and patented technology incorporated therein. IPOD has been used as a mark with all of these products.

The phenomenal popularity of the IPOD media player gave rise to an entire industry of IPOD accessories and related products and, as testament to its status as a cultural icon, is often abbreviated by the media and the public as simply "POD" (indeed, the term POD PEOPLE is commonly used by the media to identify fans and consumers of IPOD media players). Under well established precedent, the public's use of POD as a nickname for Apple's IPOD media player inures to Apple's benefit and thus provides Apple with enforceable rights in POD wholly independent of its enforceable rights in its IPOD mark. Apple also owns a Section 44(e) Registration for its POD mark.

Against this backdrop, and well after Apple's heralded launch of the IPOD media player, Applicant Sector Labs LLC ("Sector" or "Applicant") filed on February 14, 2003, an intent-to-use Application Serial No. 78/215,335 seeking registration on the Principal Register of the mark VIDEO POD for "Video projectors using an optical means to reproduce moving picture signals on a remote surface, for business and entertainment purposes" in International Class 9. Applicant has conceded that its VIDEO POD video player, when introduced (Applicant has yet to begin using the mark) will be compatible with Apple's IPOD media players. Applicant has likewise conceded, on multiple occasions, that its VIDEO POD mark is descriptive of its video player, which, in marked contrast to Apple's IPOD media player, is in fact pod-shaped.

The Board should refuse registration of Applicant's VIDEO POD mark on two independent grounds. First, registration should be refused under Section 2(d) of the Trademark Act because, in light of the enormous fame of Apple's IPOD mark, the high degree of relatedness of the goods at issue, the high degree of similarity of the marks and other relevant factors discussed below, Applicant's mark is confusingly similar to Apple's IPOD and POD marks.

Second, registration should be refused under Section 2(e) of the Trademark Act because, in the context of Applicant's *pod-shaped* portable video player (and in marked contrast to Apple's coined and fanciful IPOD mark), Applicant's VIDEO POD mark is merely descriptive of Applicant's goods. Indeed, Applicant has, in fact, expressly conceded the descriptive nature of its VIDEO POD mark. Since Applicant has yet to commence use of the mark, Applicant is incapable of showing that this descriptive term has acquired secondary meaning.

Accordingly, and for the reasons explained in more detail below, Applicant's application should be refused and Apple's opposition sustained.

II. LEGAL ISSUES PRESENTED

A. Whether Applicant's VIDEO POD mark so resembles Apple's IPOD mark, registered and used by Apple and its licensees, for goods virtually identical to and/or closely related to Applicant's, and Apple's registered POD mark, used by the public to refer to the IPOD media player, so as to be likely to cause confusion, mistake, or deception in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), with consequent injury to Apple and the public.

B. Whether Applicant's VIDEO POD mark is merely descriptive of Applicant's video players, and therefore unregistrable under Section 2(e) of the Trademark Act, 15 U.S.C. § 1052(e) without a finding of acquired distinctiveness.

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III. DESCRIPTION OF THE TRIAL RECORD

A. Evidence Submitted by Apple

Apple has made the following testimony of record:¹

1. Thomas La Perle, Esq., Assistant Secretary, Legal, for Apple Inc., Testimonial Deposition Transcript dated September 8, 2010, and Exhibit Nos. 1-35.² See Dkt. Nos. 82-84.

Apple has filed the following Notices of Reliance during its testimony period:³

2. Opposer's Notice of Reliance, dated September 20, 2010, with Exhibits 1 through 213. See Dkt. Nos. 63-68.
3. Opposer's Second Notice of Reliance, dated May 2, 2011, with Exhibits 214 through 222. See Dkt. No. 81.

B. Evidence Submitted by Applicant

Applicant has made the following testimony of record:

1. Daniel Kokin, President and Founder of Sector Labs, LLC, Testimonial Deposition Transcript dated November 15, 2010, and Defendant's Exhibit Nos. 1-5 and Plaintiff's Exhibits A-J. See Dkt. Nos. 79-80.

Applicant filed the following Notice of Reliance during its testimony period:⁴

2. Applicant's Notice of Reliance No. 1, dated November 19, 2010. See Dkt. Nos. 70-71.

C. Evidence Automatically of Record Pursuant to 37 C.F.R. 2.122(B)(1)

1. The file of Sector Labs LLC's U.S. Trademark Application Serial No. 78/215,335 for the mark VIDEO POD ("VIDEO POD App. File").

¹ References to pages of testimonial deposition transcripts and accompanying exhibits filed with the Board by the parties herein will be designated as "____ Depo. __, Ex. __ at ____."

² As indicated both on the record and in the testimony transcript, Mr. La Perle's deposition transcript and all accompanying exhibits are designated CONFIDENTIAL pursuant to the Board's standardized protective order operative in this opposition, and were filed under seal.

³ Notices of Reliance and accompanying exhibits filed during Opposer's testimony period are designated as "Opposer's Not. of Rel. __, Ex. __ at ____."

⁴ Notices of Reliance and accompanying exhibits filed during Applicant's testimony period are designated as "Applicant's Not. of Rel. __, Ex. __ at ____."

IV. RECITATION OF FACTS

A. Apple and its Famous IPOD Mark and Product

Beginning with its launch from a Silicon Valley garage in the 1970s, Apple is one of the most legendary business success stories in American history. First igniting the personal computer revolution, and then revolutionizing other consumer industries, Apple today is one of the most innovative and admired companies in the world, enjoying tremendous success in a variety of industries, including computer hardware, software, consumer electronic devices, and digital media.⁵ Its products are widely distributed throughout the United States and the world, through Apple's own retail and online stores, and an extensive network of authorized distributors and resellers.⁶ The popularity of Apple's goods and services is reflected in Apple's remarkable sales figures. Between 2001 and 2009 alone, Apple generated over \$151.7 billion in net sales revenue, and approximately \$88 billion (about 58%) resulted from sales to customers in the United States.⁷

While Apple has had many product successes and is associated with many famous trademarks, one of its most successful products to date has been the IPOD media player. As a result of its extensive sales, advertising, and unsolicited media attention, Apple's IPOD mark and the associated media player are recognized throughout the world and associated strongly with Apple. The IPOD mark is plainly famous, as Applicant admits.⁸

⁵ La Perle Depo. 10:3-11.

⁶ La Perle Depo. 10:19-11:4.

⁷ Opposer's Not. of Rel. 1, Ex. 4 at 27 and Ex. 8 at 37; *see also* Ex. 1 at 12, Ex. 2 at 11, Ex. 3 at 17, Ex. 4 at 16, Ex. 5 at 19, Ex. 6 at 14, Ex. 7 at 13 and Ex. 8 at 14.

⁸ Opposer's Not. of Rel. 1, Ex. 205, at 6, and Ex 206, at 5.

1. Apple Has Sold Hundreds of Millions of Goods Under the IPOD Mark

On October 23, 2001, Apple announced the IPOD music player, a breakthrough portable music player that was capable of storing and playing up to 1000 songs, all in a pocket-sized device.⁹ The product was an immediate and enormous success. From the first shipments of the product on November 10, 2001, to the end of that calendar year, Apple sold over 125,000 IPOD media players.¹⁰ By the end of Apple's fiscal year 2002, 381,000 units had been sold, generating \$143 million in revenue, and the following year, nearly 939,000 units were sold, generating \$345 million in revenue.¹¹ Sales of IPOD media players increased dramatically over time, as set out below.¹²

Fiscal Year Ended Sept	iPod Units Sold	iPod Revenue
2002	381,000	\$143M
2003	939,000	\$345M
2004	4,416,000	\$1.306B
2005	22,497,000	\$4.540B
2006	39,409,000	\$7.676B
2007	51,630,000	\$8.305B
2008	54,828,000	\$9.153B
2009	54,132,000	\$8.091B

On April 9, 2007, Apple announced that 100 million IPOD media players had been sold.¹³ As of September 2010, some 250 million units of IPOD media players had been sold.¹⁴

⁹ La Perle Depo. 41:6-23, Ex. 8; Opposer's Not. of Rel. 1, Ex. 1 at 2, and Ex. 14.

¹⁰ La Perle Depo. 84:7-85:1, Ex. 2.

¹¹ La Perle Depo. 86:1-87:17, Exs. 31 and 32; Opposer's Not. of Rel. 1, Ex. 1 at 19-20, Ex. 2 at 19.

¹² La Perle Depo. 85:2-90:5, Exs. 31-35; Opposer's Not. of Rel. 1, Ex. 1 at 19-20, 48, Ex. 2 at 18-19, 48, Ex. 3 at 30-31, 73, Ex. 4 at 32, 70, Ex. 5 at 54 and 82, Ex. 6 at 44-45, 67, Ex. 7 at 43, 65, and Ex. 8 at 43, 66.

¹³ Opposer's Not. of Rel. 1, Ex. 110.

¹⁴ La Perle Depo. 83:16-84:6; Opposer's Not. of Rel. 1, Ex. 1 at 19-20, 48, Ex. 2 at 18-19, 48, Ex. 3 at 30-31, 73, Ex. 4 at 32, 70, Ex. 5 at 54 and 82, Ex. 6 at 44-45, 67, Ex. 7 at 43, 65, and Ex. 8 at 43, 66.

2. Apple's Line of IPOD Media Players

The first IPOD released in November 2001 was a digital music playing device, with some additional functionality including a contacts list and a calendar, with a suggested retail price of \$299 and \$399.¹⁵ The IPOD product offerings have evolved over time, to capture greater functionality, with Apple offering the ability to store and display photos on the IPOD added with the release of the IPOD PHOTO on October 26, 2004,¹⁶ and video capability included in the fifth generation IPOD, released on October 12, 2005.¹⁷ Over the last ten years, Apple has released new generations and variations of its IPOD product, such that the device is now more accurately characterized as a handheld digital content device as opposed to a music player.¹⁸ Consumers today enjoy a full line of IPOD products, including the IPOD CLASSIC, the IPOD NANO, the IPOD TOUCH, and the IPOD SHUFFLE, with varying price points and capabilities.¹⁹ The current suggested retail prices vary between \$50 and \$400, with all but the lowest end IPOD SHUFFLE device capable of playing video.²⁰

3. The IPOD Media Player Is Widely Distributed and the IPOD Mark Has Been Seen by Many Millions of Consumers Each Year

Apple has used the IPOD mark continuously since the November 2001 launch of the media player.²¹ On each of the over 250 million IPOD media players sold, the IPOD mark appears on the packaging and on the product itself.²²

¹⁵ La Perle Depo. 39:13-19, 46:11-47:11; Opposer's Not. of Rel. 1, Ex. 14.

¹⁶ La Perle Depo. 50:21-51:15, Ex.13; Opposer's Not. of Rel. 1, Ex. 131.

¹⁷ La Perle Depo. 39:13-19, 49:6-50:18, Exs. 14 and 15; Opposer's Not. of Rel. 1, Ex. 132.

¹⁸ La Perle Depo. 39:13-19; Opposer's Not. of Rel. 1, Ex. 14, 102-116, 131, 132.

¹⁹ La Perle Depo. 42:22-43:10, 49:6-50:13, Ex.13; Opposer's Not. of Rel. 1, Ex. 14 at 19-20, 48, Ex. 2 at 18-19, 48.

²⁰ La Perle Depo. 49:24-50:20, 54:15-55:14, and Ex. 13.

²¹ La Perle Depo. 41:8-42:21, Ex. 8 and Ex. 13; Opposer's Not. of Rel. 1, Ex. 119.

The IPOD product is widely distributed online, through Apple's Apple Store[®], and via third party distributors and retailers.²³ By visiting Apple's online Apple Store[®] retail service, introduced in November 1997 and accessible through its website at apple.com, consumers may purchase Apple's entire product line including the IPOD media player.²⁴ Apple's website and its online Apple Store[®] retail service, are extraordinarily popular websites and accessed by many millions of people each year.²⁵

Consumers are further exposed to the IPOD mark and may purchase the media player at Apple's brick-and-mortar stores. The first brick-and-mortar Apple storefront was opened in May 2001, and there are now more than 230 such stores in the United States alone.²⁶ Each of these stores offers the IPOD product for sale and prominently displays the IPOD mark.²⁷

In addition to being sold through Apple's stores, the IPOD media player is widely available in many prominent, national retail store chains. Among the many authorized resellers of IPOD products are some of the largest retailers in the United States, including Circuit City, Sears, Best Buy, Costco, Target, Amazon.com and Walmart.²⁸

Footnote continued from previous page

²² La Perle Depo. 42:11-21.

²³ La Perle Depo. 39:13-19, 79:11-80:2.

²⁴ La Perle Depo. 39:13-19, 46:22-47:11, 81:11-25, Ex. 6 and Ex. 11; Opposer's Not. of Rel. 1, Ex. 119-121, 134, 136-137.

²⁵ La Perle Depo. 82:21-25; Opposer's Not. of Rel. 1, Exs. 185-188.

²⁶ La Perle Depo. 79:11-81:10, 82:7-20, Exs. 29-30; Opposer's Not. of Rel. 1, Ex. 142.

²⁷ La Perle Depo. 79:11-81:10.

²⁸ La Perle Depo. 83:2-83:15; Opposer's Not. of Rel. 1, Exs. 122-129.

4. Apple Has Extensively Advertised and Promoted the IPOD Mark

Apple has spent many millions advertising and promoting its goods and services under the IPOD mark.²⁹ The advertising and promotional efforts are simply astounding in quantity and scope.³⁰ The total amount Apple has spent on advertising its products and services during the period 2001 to 2009 is set out below:

Year Ended Sept.	Advertising Expenditures
2001	\$261M
2002	\$209M
2003	\$193M
2004	\$206M
2005	\$287M
2006	\$338M
2007	\$467M
2008	\$486M
2009	\$501M

A large portion of the above totals was devoted to promoting the IPOD media player, as one of the company's key products.³¹ Apple's iconic advertising campaign, which includes outdoor billboards, posters and other signage, as well as prominent advertisements in popular magazines, on television and on the internet,³² has undoubtedly reached a large portion of the United States public.

a) Apple's Widely Covered Product Press Releases

Apple has regularly issued press releases announcing new products and new features of its existing products.³³ Many of these press releases have discussed and promoted the IPOD product. The

²⁹ La Perle Depo. 69:25-70:21.

³⁰ La Perle Depo. 70:7-70:17.

³¹ La Perle Depo. 69:25-70:20, 85:14-86:14, 90:6-92:8, Ex. 2 at 2-3, Exs. 31-35; Opposer's Not. of Rel. 1, Ex. 1 at 48, Ex. 2 at 48, Ex. 3 at 73, Ex. 4 at 70, Ex. 5 at 82, Ex. 6 at 67, Ex. 7 at 65 and Ex. 8 at 66.

³² La Perle Depo. 70:7-21.

³³ Opposer's Not. of Rel. 1, Ex. 14, 102 to 116, 131 & 132.

press releases have been widely distributed and are frequently extensively covered by the media and others.³⁴

b) Apple's Print Advertising

Apple has consistently advertised its IPOD product in some of the most popular magazines in the United States. Advertisements featuring the IPOD—which are generally placed in prominent locations in the magazine (e.g., as multi-page layouts or on the back page)—have appeared in such leading publications as *The New Yorker*, *Wired*, *Fortune*, *Esquire*, *Newsweek*, *Time*, *BusinessWeek*, *Sports Illustrated*, *Vanity Fair*, *Vogue*, and *Rolling Stone*.³⁵

c) Apple's Television Advertising

Apple has extensively advertised its IPOD products on television, including on many network and cable television stations, including ABC, NBC, MSNBC, Fox News, MTV, ESPN and others.³⁶ These commercials feature the IPOD mark and have been viewed by consumers in the U.S. billions of times.

d) Apple's Outdoor Advertising

Since the launch of the product, Apple has extensively and continuously promoted the IPOD media player through outdoor advertising campaigns, including use of eye-catching and distinctive billboards, posters, murals, and subway, bus, and bus-shelter advertisements in major cities across the nation.³⁷ Apple's iconic "silhouette" IPOD and iTunes advertising campaign is an example of Apple's well-known outdoor advertisements.³⁸ These advertisements have featured the IPOD and iTunes® marks and products.

³⁴ La Perle Depo. 31:11-32:10.

³⁵ La Perle Depo. 70:22-73:16, Ex. 25; Opposer's Not. of Rel. 1, Ex. 141.

³⁶ La Perle Depo. 78:2-19; Opposer's Not. of Rel.1, Exs.117-118.

³⁷ La Perle Depo. 71:24-75:6 & Ex. 25, 26, 27; Opposer's Not. of Rel. 1, Ex.141 at 2.

³⁸ La Perle Depo. 71:24-78:1 ; Ex. 25, 26, 27, 28; Opposer's Not. of Rel. 1, Ex. 141 at 2.

e) Apple's Internet Advertising

Since the launch of the IPOD in 2001, Apple has used the internet for advertising and promoting the IPOD media player. Apple has an extensive internet presence, including its apple.com, Apple Store®, and iTunes Store® websites.³⁹ These sites, each of which have featured and promoted the IPOD mark for many years, are seen by millions of consumers each year. In addition to advertising through its own websites, Apple promotes its goods and services by placing prominent banner advertisements on major media websites such as the *New York Times*'s website.⁴⁰

5. The IPOD Has Received Extensive Unsolicited Media Attention

Apple's famous IPOD mark and the groundbreaking IPOD media player have attracted an unprecedented level of widespread and unsolicited attention from national and local media outlets. Apple and its IPOD product have been the subject of many thousands of articles and featured in many national general-interest publications, including *The Wall Street Journal*, *The New York Times*, *Time*, *Newsweek*, *USA Today*, and *Fortune*, as well as major industry periodicals such as *BusinessWeek*, *MacWorld* and *PCWorld*.⁴¹

This attention to the IPOD media player was evident immediately after the product was launched. For example, Walter Mossberg, a prominent technology writer for *The Wall Street Journal*, lauded the IPOD media player in an article captioned "Apple Brings Its Flair for Smart Designs to Digital Music Player," which was published in the *Journal* on November 1, 2001.⁴² Many other prominent newspapers,

³⁹ La Perle Depo. 46:22-47:11, 78:21-79:23, 81:11-83:1, Ex. 6; Opposer's Not. of Rel. 1, Exs. 119-121, 134, 136-137, 185-188.

⁴⁰ La Perle Depo. 78:20-79:10.

⁴¹ Representative samples are found in Opposer's Not. of Rel. 1, Exs. 143-182. See also Exs. 47-100.

⁴² La Perle Depo. 44:23-46:16, Ex. 10; 79:10; Opposer's Not. of Rel. 1, Ex. 149.

including the *San Francisco Chronicle*, the *Philadelphia Inquirer* and the *Los Angeles Times*, similarly published highly favorable articles about the IPOD shortly after its launch in 2001.⁴³

As sales of the IPOD grew exponentially, the unsolicited media coverage kept pace. For example, the May 12, 2003 edition of *Fortune Magazine* featured a cover story on Apple's success in moving into the music business, with the cover photograph showing musician Sheryl Crow standing with an IPOD media player, and Apple's founder Steve Jobs sitting beside her listening to the IPOD through earbuds.⁴⁴ Similarly, a February 2, 2004 *BusinessWeek* magazine featured a cover story on Apple, with the cover photograph showing Steve Jobs holding an IPOD media player.⁴⁵ The *cover story* of the July 26, 2004 edition of *Newsweek* was entitled "iPod, Therefore, I Am" (with a subtitle "Steve Jobs and the Must-Have Music Player Everyone is Talking About"), also featured a photograph of Steve Jobs holding an IPOD media player.⁴⁶ In a June 27, 2005 story in *Fortune* magazine, entitled "It's iPod's Revolution: We Just Live In it," author Andy Serwer stated: "[i]t's hard to recall any branded recreational product that has carried the cultural oomph that the iPod now has. The Hula-Hoop was a fad...As for the Walkman, the iPod's mobile-music ancestor, it generated massive sales. But it never impacted behavior or peripheral markets quite the way the iPod has."⁴⁷

6. Apple's U.S. Trademark Registrations for IPOD

Apple is the registered owner of more than eleven U.S. trademark registrations for marks consisting in whole or part of IPOD.⁴⁸ Apple's registrations for the IPOD mark, cover, *inter alia*, portable

⁴³ La Perle Depo. 47:16-48:4, Ex. 12; Opposer's Not. of Rel. 1, Exs. 147-154.

⁴⁴ La Perle Depo. 47:16-49:5, Ex. 12; Opposer's Not. of Rel. 1, Ex. 144.

⁴⁵ La Perle Depo. 47:14-48:10, Ex. 12; Opposer's Not. of Rel. 1, Ex. 143.

⁴⁶ La Perle Dep. 47:14-48:4, Ex. 12; Opposer's Not. of Rel. 1, Ex. 145.

⁴⁷ La Perle Depo. 47:14-48:4, Ex. 12; Opposer's Not. of Rel. 1, Ex. 174.

⁴⁸ La Perle Depo. 43:18-44:16, Ex. 9; Opposer's Not. of Rel. 1, Exs. 15-25.

and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing text, data, and audio and video files, and computer software for use with such devices, related goods and services, including “ video viewers, namely video monitors for portable and handheld digital electronic devices,” and a variety of other goods and services spanning a number of International Classes including 9, 16, 22, 25, 28, 35, 38, 39, 41 and 42.⁴⁹ Relevant registrations, each of which is in full force and effect, are set out in the chart below.

MARK	REG. NO.	PRIORITY FILING DATE/ REG. DATE	GOODS/SERVICES
IPOD	2,835,698 ⁵⁰	Aug 31, 2001 ⁵¹ / April 27, 2004	Portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing audio files; computer software for use in organizing, transmitting, manipulating, and reviewing audio files on portable and handheld digital electronic devices in Intl Class 9
IPOD	3,089,360	Aug 31, 2001/ May 9, 2006	Portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing text, data, and audio files; computer software for use in organizing, transmitting, manipulating, and reviewing text, data, and audio files on portable and handheld digital electronic devices in Intl Class 9
IPOD	3,341,191	June 18, 2005/ Nov 20, 2007	full line of electronic and mechanical parts and fittings for portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing text, data, audio and video files; electronic docking stations; stands specially designed for holding portable and handheld digital electronic devices; battery chargers; battery packs; electrical connectors, wires, cables, and adaptors; wired and wireless remote controls for portable and handheld digital electronic devices; headphones and earphones; stereo amplifier and speaker base stations; automobile stereo adapters; audio recorders; radio receivers; radio transmitters; video viewers, namely video monitors for portable and

⁴⁹ Opposer’s Not. of Rel. 1, Exs. 15-25.

⁵⁰ An affidavit has been filed and accepted pursuant to Sections 8 and 15 of the Lanham Act for Registration No. 2,835,698, rendering that registration incontestable.

⁵¹ Apple applied for registration of the first two marks prior to February 14, 2003, the date on which Applicant filed its intent-to-use application for the mark VIDEO POD.

MARK	REG. NO.	PRIORITY FILING DATE/ REG. DATE	GOODS/SERVICES
			handheld digital electronic devices; and computer software for portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing text, data, audio, image, and video files; computer application software for recording and organizing calendars and schedules, to-do lists, and contact information; computer game software; and, computer software for clock and alarm clock functionality; carrying cases, all for use with portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing text, data, audio, image, and video files in Intl Class 9
IPOD	3,823,241	June 18, 2005/ July 20, 2010	Clothing, namely, sweaters, sweatshirts, jogging suits, jackets, and coats; footwear in Intl Class 25
IPOD	3,497,047	June 18, 2005/ Sept 2, 2008	International Class 09: Full line of holders, straps, armbands, lanyards, and clips for portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing text, data, audio, image, and video files International Class 22: Lanyards for portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing text, data, audio, image, and video files
iPod	3,741,470	April 3, 2006/ Jan 26, 2010	International Class 09: Portable and handheld digital electronic devices for recording, organizing, transmitting, receiving, manipulating, playing and reviewing text, data, image, audio and video files; computer software for use in organizing, transmitting, receiving, manipulating, playing and reviewing text, data, image, audio, and video files on portable and handheld digital electronic devices; a full line of electronic and mechanical parts and fittings for portable and handheld digital electronic devices for recording, organizing, transmitting, receiving, manipulating, playing and reviewing text, data, image, audio and video files; electronic docking stations; stands specially designed for holding portable and handheld digital electronic devices; battery chargers; battery packs; electrical connectors, wires, cables, and adaptors; wired and wireless remote controls for portable and handheld digital electronic devices; headphones and earphones; stereo amplifier and speaker base stations; automobile stereo adapters; audio recorders; radio receivers; radio transmitters;

MARK	REG. NO.	PRIORITY FILING DATE/ REG. DATE	GOODS/SERVICES
			<p>image scanners; video viewers, namely, video monitors for portable and handheld digital electronic devices; electronic memory card readers; a full line of computer software for portable and handheld digital electronic devices for recording, organizing, transmitting, receiving, manipulating, playing and reviewing text, data, audio, image, and video files; computer application software for recording and organizing calendars and schedules, to-do lists, and contact information; computer game software; computer software for clock and alarm clock functionality; carrying cases, sacks, and bags, all for use with portable and handheld digital electronic devices; a full line of holders, straps, armbands, and clips for portable and handheld digital electronics. computers, computer peripherals, hand held computers, computer terminals, personal digital assistants, electronic organizers, electronic notepads, apparatus for recording, transmission and reproduction of text, data, image, audio, and video; blank magnetic data carriers; microprocessors, memory boards, computer and video monitors, liquid crystal displays, keyboards, electrical cables, modems, printers, digital disk drives; cameras; computer software and prerecorded computer programs for personal information management, database management software, electronic mail and messaging software; paging software; database synchronization software, computer programs for accessing, browsing and searching online databases; computer software and firmware for operating system programs; data synchronization programs; computer software application development tool programs; adapters, computer card adapters, cable and electric connectors and computer hard drives; blank random access electronic memory, read only electronic memory; solid state electronic memory; user manuals in electronically readable, machine readable or computer readable form for use with, and sold as a unit with, all the aforementioned goods; downloadable electronic publications in the nature of books, magazines, pamphlets, brochures, newsletters, journals and magazines in the fields of sporting and cultural events, computer hardware and software applications, K-12 education and university-level subjects, and a wide range of topics of general interest</p> <p>Also various goods and services in classes 16, 22, 25, 28, 35, 38, 39, 41 and 42</p>

MARK	REG. NO.	PRIORITY FILING DATE/ REG. DATE	GOODS/SERVICES
IPOD CLASSIC	3,517,722	June 21, 2007/ Oct 14, 2008	Portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing text, data, audio and video files; computer software for use in organizing, transmitting, manipulating, and reviewing text, data, audio and video files on portable and handheld digital electronic devices in Intl Class 9
IPOD TOUCH	3,489,972	June 21, 2007/ Aug 19, 2008	Portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing text, data, audio and video files; computer software for use in organizing, transmitting, manipulating, and reviewing text, data, audio and video files on portable and handheld digital electronic devices in Intl Class 9
IPOD NANO	3,192,683	June 24, 2005/ Jan 2, 2007	Portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing text, data, and audio files; computer software for use in organizing, transmitting, manipulating, and reviewing text, data, and audio files on portable and handheld digital electronic devices in Intl Class 9
MADE FOR IPOD & Design	3,341,286	Aug 10, 2005/ Nov 20, 2007	full line of electronic and mechanical parts and fittings for portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing text, data, audio and video files; electronic docking stations; stands specially designed for holding portable and handheld digital electronic devices; battery chargers; battery packs; electrical connectors, wires, cables, and adaptors; wired and wireless remote controls for portable and handheld digital electronic devices; headphones and earphones; stereo amplifier and speaker base stations; automobile stereo adapters; audio recorders; radio receivers; radio transmitters; video viewers, namely, video monitors for portable and handheld digital electronic devices; and carrying cases, all for use with portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing text, data, audio, image, and video files in Intl Class 9
IPOD SHUFFLE	3,453,564	Nov 14, 2007/ June 24, 2008	Portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing text, data, and audio files; computer software for use in organizing, transmitting, manipulating, and reviewing text, data, and audio files on portable and handheld digital electronic devices in Intl Class 9

7. Apple Protects and Polices Third-Party Uses of Its IPOD Mark

In light of the significant value of the IPOD mark and its critical importance to the company, Apple makes active and vigorous efforts to protect its mark and police infringing third-party uses.⁵² Among these efforts are Apple's use of watch services to identify potentially infringing trademark applications and its filings of trademark oppositions and pursuit of litigation when appropriate.⁵³ Apple also publishes a set of stringent guidelines to govern use of Apple's marks by licensees and other third parties.⁵⁴ In addition, Apple commences proceedings in the U.S. and internationally, as necessary, to prevent the registration and/or use of potentially infringing third-party marks.⁵⁵

8. IPOD Accessories and the Made for IPOD Licensing Program

Since the time the product was first launched and continuously thereafter, Apple has offered accessories to be used in connection with the IPOD media player, including cases, docking stations, chargers, headphones, charging cables, connector cables, and other goods.⁵⁶ The IPOD mark appears on each of these accessories, either on the product packaging or on the product itself.⁵⁷

The success of the IPOD has also created an entire industry or "ecosystem" offered by third parties seeking to participate in the new market created by Apple's revolutionary product.⁵⁸ Major consumer electronic companies such as Bose, Sony, Yamaha, Altec Lansing and Griffith have entered the lucrative IPOD accessories market and produce a wide range of products to be used with the IPOD media

⁵² La Perle Depo. 65:15-67:23; Opposer's Not. of Rel. 1, Ex. 136.

⁵³ La Perle Depo. 65:15-67:23; Opposer's Not. of Rel. 1, Ex. 211.

⁵⁴ La Perle Depo. 67:24-69:6, Ex. 24; Opposer's Not. of Rel. 1, Ex. 212.

⁵⁵ La Perle Depo. 65:15-67:23, 69:7-24; Opposer's Not. of Rel. 1, Ex. 211.

⁵⁶ La Perle Depo. 55:15-56:3.

⁵⁷ La Perle Depo. 56:4-56:14.

⁵⁸ La Perle Depo. 57:3-58:20, Ex. 17.

player, including such goods as speakers, car adaptors, headphones, and remote controls, some of which are advertised and sold through Apple's website.⁵⁹ Many of these third party products have been developed to enhance the functionality of the IPOD and to make it compatible with other products.

Apple has licensed the use of its IPOD mark to other parties for use in connection with a wide range of accessories for the IPOD media player as part of the MADE FOR IPOD ("MFi") program, first launched in March 2005.⁶⁰ Specifically, Apple licenses to other companies its proprietary 30-pin connector technology that allows other devices to connect to the IPOD, and thereby permits these third parties to offer their own products that control, enhance or manipulate the functionality of the IPOD media player.⁶¹ As part of the technology license, Apple also allows these companies the use of a logo incorporating the IPOD mark, referred to as the MADE FOR IPOD logo, to show the product's compatibility with Apple's IPOD media player.⁶² Among the many MFi licensees are at least several companies that make projectors for use with the IPOD media player, including Optoma, Viewsonic, and MicroVision.⁶³ The MADE FOR IPOD logo is used in connection with the advertisement, promotions and sales of these companies' projectors, as well as on the product packaging.⁶⁴

B. Apple's POD Mark

The public has long been using POD as an abbreviation for Apple's famous IPOD media players.⁶⁵ Newspaper and magazine articles, as well as blogs, are replete with uses of POD to refer to the

⁵⁹ La Perle Depo. 56:15-58:20, Ex. 17; Opposer's Not. of Rel. 1, Exs. 133, 134, 136-137.

⁶⁰ La Perle Depo. 58:21-60:25, Ex. 9.

⁶¹ La Perle Depo. 58:21-60:25; Opposer's Not. of Rel. 1, Ex. 135.

⁶² La Perle Depo. 58:21-60:25; Opposer's Not. of Rel. 1, Ex. 24.

⁶³ La Perle Depo. 61:1-65:11, Exs. 18-22; Opposer's Not. of Rel. 1, Exs. 138-140.

⁶⁴ La Perle Depo. 61:1-65:11, Exs. 18-22; Opposer's Not. of Rel. 1, Exs. 138-140.

⁶⁵ Opposer's Not. of Rel. 1, Exs. 46-100.

IPOD product.⁶⁶ Similarly, television discussions have used POD in place of the IPOD mark to refer to the IPOD media player.⁶⁷ A new term, POD PEOPLE, has been coined and is commonly used in the media to identify the fans and consumers of IPOD media players.⁶⁸ Apple itself authorized the use of POD as an abbreviation for IPOD in an advertising campaign with the automobile manufacturer Volkswagen, using the tagline “PODS unite.”⁶⁹ Applicant’s own documents show use of POD to refer to the IPOD media player.⁷⁰ As such, the use of POD in connection with portable and handheld media players and related goods and services is widely understood as a nickname for the IPOD media player and is closely associated with Apple.

Apple also owns a registration for the POD mark, which issued on September 7, 2010, pursuant to Section 44(e) of the Trademark Act for “Portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing audio files, and peripherals for use therewith; computer software for use in organizing, transmitting, manipulating, and reviewing audio files on portable and handheld digital electronic devices; none of the above goods being digital signal processing hardware and software used for audio signal manipulation for real or virtual musical instruments” in International Class 9.⁷¹

⁶⁶ Opposer’s Not. of Rel. 1, Exs. 46-100.

⁶⁷ Opposer’s Not. of Rel. 1, Ex. 69 at 3, 70 at 6, 71 at 7.

⁶⁸ Opposer’s Not. of Rel. 1, Exs. 46-49, 55-56, 58, 68, 75, 92, 97.

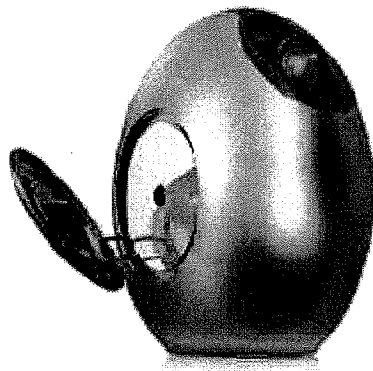
⁶⁹ La Perle Depo. 99:25-101:13; Opposer’s Not. of Rel. 1, Ex. 101.

⁷⁰ Opposer’s Not. of Rel. 1, Ex. 196.

⁷¹ Opposer’s Not. of Rel. 1, Ex. 26.

C. Applicant Seeks a Registration for VIDEO POD for a Pod-shaped Video Player

On February 14, 2003, Applicant, a product and concept development company,⁷² filed an intent-to-use Application Serial No. 78/215,335 to register the mark VIDEO POD in connection with “Video projectors using an optical means to reproduce moving picture signals on a remote surface, for business and entertainment purposes” in International Class 9.⁷³ As Applicant has admitted on numerous occasions, the term VIDEO POD was intended to describe Applicant’s *pod-shaped* video player as depicted in one of Applicant’s sales brochures for its not yet commercially available player:⁷⁴



Coupled with a built-in DVD player, the Video Pod™ makes large screen entertainment as simple as plug-and-play.

Further, Applicant has admitted that it was familiar with Apple and its IPOD mark before it filed the application seeking exclusive rights to the VIDEO POD mark,⁷⁵ and further conceded the IPOD mark is famous.⁷⁶ In addition to selecting a highly similar mark as Apple’s, the record is replete with other indications that Applicant studied Apple’s products in developing its own and intended to trade on this

⁷² Kokin Depo. 5:17-6:4.

⁷³ VIDEO POD App. File.

⁷⁴ Opposer’s Not. of Rel. 1, Ex. 204.

⁷⁵ Kokin Depo. 5:17-6:4, 28:24-29:1; Opposer’s Not. of Rel. 1, Exs. 205 and 206 at 2.

⁷⁶ Kokin Depo. 42:24-43:11, 51:23-10, 54:8-55:7, 56:18-58:8, Exs. C, E to G; Opposer’s Not. of Rel. 1, Exs. 196-199. The parties stipulated to the authenticity of the documents it produced. Opposer’s Not. of Rel. 1, No. 213.

fame and good will.⁷⁷ Indeed, Applicant's founder has testified that, in developing the VIDEO POD he was inspired to make Applicant's product "look better than Apple."⁷⁸ He also admitted that he displayed an image of an IPOD media player on his company's website around 2006-2007 "because [he] thought it looked cool."⁷⁹

Applicant's VIDEO POD video player was intended to be a "video projector for the masses", that is an affordable personal cinema device, with a price of a few hundred dollars that would be available in standard retail outlets, such as Best Buy and Circuit City.⁸⁰ The record is clear that Applicant's product has the capacity to be used as a compatible product with the IPOD media player.⁸¹ Also, one of Applicant's potential competitors in this market was ViewSonic, a video projector manufacturer,⁸² and Apple's MFI licensee.

Although eight years have passed since the intent-to-use application was first filed, Applicant expressly and unequivocally admits that it has never used the VIDEO POD mark in commerce.⁸³

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⁷⁷ Opposer's Not. of Rel. 1, Exs. 196-198.

⁷⁸ Kokin Depo. 22:22-23.

⁷⁹ Kokin Depo. 46:11-47:3 Opposer's Not. of Rel. 1, Ex 205.

⁸⁰ Kokin Depo. 40:17-41:13.

⁸¹ Kokin Depo. 78:5-9; Opposer's Not. of Rel. 1, Ex. 208, at 3: "The goods/services identified in the VIDEO POD Trademark Application are, can or will be used in connection with the handheld and portable media devices that Apple promotes under the IPOD Mark..." While Mr. Kokin of Applicant quibbles that the IPOD device did not have video capability when he selected VIDEO POD as his mark, he also admits that he was not surprised to hear in 2005 that Apple came out with an IPOD product with video capabilities when the product was announced. Kokin Depo. 24:1-8.

⁸² Kokin Depo. 25:2-9.

⁸³ Answer to Second Amended Notice of Opposition ¶ 17. See Dkt. No. 56.

D. The Extensive Record Showing Applicant's Use of VIDEO POD is Descriptive

Applicant, which has a history of picking highly descriptive names for its products,⁸⁴ has conceded on numerous occasions that its VIDEO POD mark is merely descriptive of its *pod-shaped* video player. This evidence conclusively establishes that the purported mark is merely descriptive of a pod-shaped video player and is therefore unregistrable on the Principal Register absent acquired distinctiveness.

1. Applicant Admits that "VIDEO POD" Describes its Claimed Goods

Applicant repeatedly admits that VIDEO POD describes its *pod-shaped* video players, as shown by the following discovery responses:

- "Sector intends to sell pod-shaped video projectors under the VIDEO POD mark."⁸⁵
- "The VIDEO POD mark is believed to have been used to describe its associated device back in 2002...The VIDEO POD mark is still used to describe its associated device."⁸⁶
- "While 'POD' denotes a pod-like appearance, the 'VIDEO' portion of the VIDEO POD mark specifically informs consumers about the product's ability to store, record, or transmit video."⁸⁷
- "The VIDEO POD Mark was/is intended to denote both form and function. The 'VIDEO' portion of the VIDEO POD Mark clearly indicates that goods and/or services under the VIDEO POD Mark have the ability to playback, record, and/or store video content. The 'Pod' portion of the VIDEO POD Mark is intended to convey a pod-like and/or pod-shaped form factor."⁸⁸

⁸⁴ For example, in his testimonial deposition, Applicant founder Daniel Kokin described the branding of other video devices contemplated by the company as follows: "Prism, in one configuration, looked like it had a very prism-like shape. And Diamond, in one of its configurations, had a diamond-like shape." Kokin Depo. 18:21-25.

⁸⁵ Opposer's Not. of Rel. 1, Ex. 209 (Response to Interrogatory No. 1).

⁸⁶ Opposer's Not. of Rel. 1, Ex. 209 (Response to Interrogatory No. 2).

⁸⁷ Opposer's Not. of Rel. 1, Ex. 206 (Response to Request for Admission No. 15).

⁸⁸ Opposer's Not. of Rel. 1, Ex. 209 (Response to Interrogatory No. 20).

- “The phrase “VIDEO POD” is intended be [sic] suggestive about the product’s form and function. The phrase is intended to convey meaning as a whole.”⁸⁹

Applicant’s founder, Daniel Kokin, confirmed the descriptive nature of the term VIDEO POD in his declaration to support Applicant’s response to Apple’s first Motion for Summary Judgment and Applicant’s Cross-Motion for Summary Judgment: “While the other prototypes were being innovated, sometime in mid-2002, as this last incarnation was taking shape, the lab began calling it the Video Pod, *as a description of its shape and function.*”⁹⁰

2. Applicant Further Admits that “POD” Describes Its Claimed Goods

In discovery responses and pleadings, Applicant also acknowledges the descriptive nature of the term “POD” as applied to Applicant’s pod-shaped video player:

- “Contrary to Apple’s assertions, the Video Pod was named for its pod shape and had nothing to do with the iPod. The Video Pod is oval shaped, approximately twelve inches in diameter with speakers on each side that bulge out, creating a pod shape.”⁹¹
- “Staying true to the organic, biomorphic natural shapes of the predecessor designs, the Product became a pod-like oval shape.”⁹²
- “...It was sometime during April or May the team noticed that many of the form factors were pod-like in their appearance. The project was subsequently referred to as the ‘Pod’ or ‘Video Pod.’”⁹³
- “The ‘Pod’ portion of the VIDEO POD Mark is intended to convey a pod-like and/or pod-shaped form factor.”⁹⁴

⁸⁹ Opposer’s Not. of Rel. 1, Ex. 210 (Supplemental Responses to Interrogatory Nos. 20 and 21).

⁹⁰ March 16, 2009 Declaration of Daniel Kokin in Support of Sector’s Response to Apple’s Motion for Summary Judgment and Sector’s Cross-Motion for Summary Judgment, ¶ 8 (emphasis added). See Dkt. No. 27.

⁹¹ Sector’s March 16, 2009 Response to Apple’s Motion for Summary Judgment and Sector’s Cross-Motion for Summary Judgment at 1. See Dkt. No. 27.

⁹² Sector’s March 16, 2009 Response to Apple’s Motion for Summary Judgment and Sector’s Cross-Motion for Summary Judgment at 3. See Dkt. No. 27.

⁹³ Opposer’s Not. of Rel. 1, Ex. 210 (Supplemental Response to Interrogatory No. 2).

⁹⁴ Opposer’s Not. of Rel. 1, Ex. 209 (Response to Interrogatory No. 21).

- “The design, staying true to the organic, biomorphic, natural shapes of its predecessors in the lab, turned into a pod-like device, with its shape very closely resembling a pod.”⁹⁵

In response to Apple’s Motion for Summary Judgment on descriptiveness grounds, Applicant proffered brand-new, self-serving and unconvincing reasons for why it adopted the “POD” portion of its mark, namely, that the “POD” component of VIDEO POD was inspired by both “pods” of whales and a scene involving an “escape pod” in the 1968 movie *2001: A Space Odyssey*.⁹⁶ Applicant has since admitted there is no written evidence whatsoever to support these belated rationalizations that the significance of “POD” is anything other than a description of Applicant’s product, as it previously stated in the numerous instances set forth above.⁹⁷

Moreover, while Mr. Kokin purportedly remembers having discussions with his colleagues about “POD” being referential to groups of whales and the escape pod in *2001: A Space Odyssey*, in his deposition he could not name a single person with whom these discussions allegedly took place.⁹⁸

Notably, even *after* Applicant changed its position about the ostensible significance of the “POD” component of VIDEO POD, Mr. Kokin admitted in his testimonial deposition that “POD” *does* describe the pod-like nature of the applied-for video players.

- Discussing the March 16, 2009 Declaration of Daniel Kokin in Support of Sector’s Response to Apple’s Motion for Summary Judgment and Sector’s Cross-Motion for Summary Judgment:

⁹⁵ March 16, 2009 Declaration of Daniel Kokin in Support of Sector’s Response to Apple’s Motion for Summary Judgment and Sector’s Cross-Motion for Summary Judgment , ¶ 8. See Dkt. No. 27.

⁹⁶ The claim that “pod” was chosen to refer to a family of products, much like a “pod” of whales, is particularly questionable, given that this definition of “pod” is fairly obscure. See, e.g., the dictionary definition for “pod” from the Merriam-Webster website, which fails to show this meaning (yet includes definitions for “pod” consistent with Applicant’s initial admissions). Opposer’s Not. of Rel. 1, Ex. 189 at p. 1. Apple notes that evidence a term is merely descriptive “may be obtained from any competent source, such as dictionaries, newspapers, or surveys.” *In re Bed & Breakfast Registry*, 229 U.S.P.Q. 818, 819 (Fed. Cir. 1986).

⁹⁷ Kokin Depo. 47:22-48:14, 49:11-14.

⁹⁸ Kokin Depo. 48:15-24, 49:15-17.

Q. Okay. If I can turn your attention to paragraph 8, this declaration states as follows: "The design, staying true to the organic, biomorphic, natural shapes of its predecessors in the lab, turned into a pod-like device, with its shape very closely resembling a pod. While the other prototypes were being innovated, sometime in mid-2002, as this last incarnation was taking shape, the lab began calling it the Video Pod, as a description of its shape and function. A true and correct copy of the final shape and design known as the Video Pod, with use of the mark as intended, is attached hereto as Exhibit 4." Do you see that?

A. Yes, I do.

* * *

Q. When you used the term "pod" in that paragraph, what were you referring to?

A. I was referring to its shape.⁹⁹

3. Applicant Also Concedes That "VIDEO" is Descriptive of Its Claimed Goods

Applicant disclaimed the term "VIDEO" in its January 23, 2004 response to a July 25, 2003 Office Action.¹⁰⁰ Thus, Applicant has conceded that the word "VIDEO" is descriptive of the video players identified in the VIDEO POD application.

4. The Purported Mark VIDEO POD Has Not Acquired Distinctiveness

Applicant has not yet used the VIDEO POD mark in commerce for the claimed goods, and admits as such in its response to one of Apple's interrogatories: "The VIDEO POD Mark has never been used in commerce."¹⁰¹ Accordingly, the VIDEO POD mark cannot have acquired distinctiveness.

V. ARGUMENT

A. Apple Has Both Standing and Priority

By virtue of Apple's uncontested ownership of valid and subsisting registrations for the IPOD and POD marks,¹⁰² Apple indisputably satisfies the threshold requirement of standing. *Lacoste Alligator*

⁹⁹ Kokin Depo. 38:4-23, Ex. B.

¹⁰⁰ Opposer's Not. of Rel. 1, Ex. 200.

¹⁰¹ Opposer's Not. of Rel. 1, Ex. 209 (Response to Interrogatory No. 3).

S.A. v. Maxoly, Inc., 91 U.S.P.Q.2d 1594, 1596 (T.T.A.B. 2009) (“Because opposer has properly made its pleaded registrations of record, opposer has established its standing.”); *Decra Roofing Sys., Inc. v. Sisson*, Cancellation No. 92043095, 2007 WL 3320324, at *1 (T.T.A.B. Oct. 31, 2007).

Similarly, in light of Apple’s existing and incontestable registrations for IPOD marks with priority dates that precede Applicant’s filing date for VIDEO POD, there is no issue as to Apple’s priority in this action. *Carl Karcher Enters. Inc. v. Stars Rests. Corp.*, 35 U.S.P.Q.2d 1125, 1128 (T.T.A.B. 1995); *Flow Tech. Inc. v. Picciano*, 18 U.S.P.Q.2d 1970, 1972 (T.T.A.B. 1991). Applicant filed the application on an intent-to-use basis, and concedes that it has never used the VIDEO POD mark in commerce.

Apple also has standing to raise an objection on the basis that Applicant’s alleged mark is merely descriptive. In *Target Brands Inc. v. Hughes*, 85 U.S.P.Q.2d 1676, 1679 (T.T.A.B. 2007), the Board stated that in order to meet the standing requirement for a descriptiveness objection, an opposer need only show “that the party objecting to such registration be engaged in the manufacture and/or sale of the same or related goods and that the product in question be one that could be produced in the normal expansion of that person’s business.” (citing *Federal Glass Co. v. Corning Glass Works*, 162 U.S.P.Q. 279, 282-83 (T.T.A.B. 1969)). See also *Yamaha Int’l Corp. v. Hoshino Gakki Co., Ltd.*, 231 U.S.P.Q. 926, 931 (T.T.A.B. 1986) (Opposer was a competitor of applicant, thus establishing the requisite real interest required for standing); *Binney & Smith Inc. v. Magic Marker Indus., Inc.*, 222 U.S.P.Q. 1003, 1010 (T.T.A.B. 1984) (“In order to establish its standing to object to the registration of an allegedly merely descriptive or deceptively misdescriptive term, a plaintiff need only show that it is engaged in the manufacture or sale of the same or related goods as those listed in the defendant’s involved application or

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¹⁰² Opposer’s Not. of Rel. 1, Exs. 27-45.

registration and that the product in question is one which could be produced in the normal expansion of plaintiff's business").

Apple indisputably has standing to object to Applicant's mark as being merely descriptive. Apple's registrations and applications cover, among other goods and services, "video viewers" and "portable and handheld digital electronic devices for recording, organizing, transmitting, receiving, manipulating, playing and reviewing text, data, image, audio and video files," while Applicant's claimed goods are "[v]ideo projectors...for business and entertainment purposes." As such, the parties are competitors based on the identification of goods claimed in their respective registrations and applications and Apple's natural zone of expansion (indeed, Apple offers several devices offering video capability). Accordingly, under clear Board precedent, Apple has standing to challenge Applicant's mark as merely descriptive.

B. There Is a Likelihood of Confusion Between Apple's IPOD and POD Marks and Applicant's VIDEO POD Mark

When assessing likelihood of confusion in an opposition proceeding under the Lanham Act § 2(d), 15 U.S.C. § 1052(d), the Board looks to whether the applicant's mark, in relation to the goods and services for which registration is sought, so resembles the opposer's use of its mark for the same or related goods and services as to be likely to cause confusion, mistake, or deception. *Nina Ricci, S.A.R.L. v. E.T.F. Enters., Inc.*, 12 U.S.P.Q.2d 1901, 1902 (Fed. Cir. 1989). In doing so, the similarity of the marks is not viewed in the abstract; rather, the Board evaluates objective evidence that the competing marks, when used in the marketplace, are likely to confuse the purchasing public as to the source of the products sold thereunder. *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 22 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1992).

In assessing likelihood of confusion, the Board should consider the fact that the widespread use of POD as a nickname for Apple's IPOD media player itself gives rise to protectable rights *regardless of the extent and scope of Apple's own use of that term*. As noted in *Nat'l Cable Television Ass'n v. Am. Cinema Editors, Inc.*, 19 U.S.P.Q.2d 1424, 937 F. 2d 1572, 1577-78 (Fed. Cir. 1991), "abbreviations and

nicknames of trademarks or names used only by the public give rise to protectible rights in the owners of the trade name or mark which the public modified. Such public use by others *inures to the claimant's benefit* and, where this occurs, public use can reasonably be deemed use 'by' that party in the sense of a use on its behalf." *Id.* (internal footnote omitted) (emphasis added); *see also Saul Zaentz Co. d/b/a Tolkien Enters. v. Bumb*, 95 U.S.P.Q.2d 1723, 2010 WL 2783893, at *4 (T.T.A.B. 2010) ("Americans are prone to abbreviate recognized trademarks and to use nicknames. Such abbreviations and nicknames are just as entitled to legal protection as the original full trademark.") (quoting 1 J.T. McCarthy, *McCarthy on Trademarks and Unfair Competition* § 7:18 (4th ed. 2009)).

To determine whether a likelihood of confusion exists, the Board considers evidence relating to the thirteen factors first articulated in *In re E.I. DuPont de Nemours & Co.*, 177 U.S.P.Q. 563 (C.C.P.A. 1973). As dictated by the evidence, not every one of these factors will be relevant to every analysis; "different elements may play the dominant role in different cases." *Nina Ricci*, 12 U.S.P.Q.2d at 1903. Further, "*all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous . . .*" *Planters Nut & Chocolate Co. v. Crown Nut Co., Inc.*, 134 U.S.P.Q. 504, 511 (C.C.P.A. 1962) (emphasis added).

In this case, the relevant *DuPont* factors are (1) the fame of Apple's IPOD mark; (2) the virtually identical and overlapping goods offered by Apple under its IPOD mark and identified in Applicant's application for use with VIDEO POD; (3) the presumed and actual overlap of the channels of trade used in connection with the marks; and (4) the similarity of Apple's IPOD and POD marks to the VIDEO POD mark in appearance, connotation and overall commercial impression. The objective evidence concerning each of these factors leaves no doubt that there is a likelihood of confusion between Apple's IPOD and POD marks, on the one hand, and Applicant's VIDEO POD mark, on the other.

1. The Fame of Apple's IPOD Mark Heavily Favors a Finding of Likelihood of Confusion

"Fame of an opposer's mark or marks . . . plays a dominant role in the process of balancing the *DuPont* factors, and famous marks thus enjoy a wide latitude of legal protection." *Bose Corp. v. QSC*

Audio Prods., Inc., 63 U.S.P.Q.2d 1303, 1305 (Fed. Cir. 2002) (quoting *Recot Inc. v. Becton*, 54 U.S.P.Q.2d 1894, 1896-97 (Fed. Cir. 2000) (quotation marks omitted); *see also Kenner Parker Toys*, 22 U.S.P.Q.2d at 1456. *DuPont* expressly instructs that a mark's fame is to be assessed by looking to the sales, advertising and length of use made in connection with that mark. 177 U.S.P.Q.2d at 567. As noted by the Federal Circuit Court of Appeals, "we have consistently accepted statistics of sales and advertising as indicia of fame: *"when the numbers are large, we have tended to accept them without any further supporting proof."* *Bose Corp.*, 63 U.S.P.Q.2d at 1306 (emphasis added).

By these measures (indeed, by any measure), and as detailed above, Apple's IPOD mark is indisputably famous and is entitled to a broad range of protection against the junior VIDEO POD mark. Indeed, Applicant admits that the IPOD mark is famous¹⁰³ and that it was aware that Apple promoted and sold portable and handheld media devices under the IPOD mark prior to the time it filed the application for VIDEO POD.¹⁰⁴

a) Length of Time of Apple's Use

Apple has made longstanding and continuous use of the IPOD mark since 2001. During this nearly ten year period, Apple has extensively used and promoted its IPOD mark and has sold hundreds of millions of media players bearing the IPOD mark. Apple has also made use of the IPOD mark with closely related if not identical goods as Applicant's. Apple's licensees have made extensive use of the IPOD mark in connection with the very goods for which Applicant seeks to register the VIDEO POD mark.¹⁰⁵

¹⁰³ Opposer's Not. of Rel. 1, Ex. 205 at 6 and Ex. 206 at 5. (RFA No. 29).

¹⁰⁴ Opposer's Not. of Rel. 1, Ex. 205 at 6 and Ex. 206 at 5. (RFA No. 6).

¹⁰⁵ La Perle Depo. 58:21-65:11, Exs. 18-22, Opposer's Not. of Rel. 1, Ex. 138-140.

b) Apple's Extensive Advertising of IPOD

As discussed above, since 2001 Apple has spent many millions in advertising and promoting its IPOD goods and services through press releases, print publications, television commercials, and Internet and outdoor advertising.¹⁰⁶ Each of these promotions and advertisements (as well as the goods themselves) have prominently displayed the IPOD mark.¹⁰⁷ Advertisements featuring IPOD—which generated intense consumer and media interest and received industry accolades—ran in prominent print publications and Internet websites, on all major network and cable television stations, and in major cities and suburbs throughout the country.¹⁰⁸

c) Apple's Extensive Sales

“[A] party may be able to demonstrate that a mark is truly famous by evidence that a large percentage of the general public . . . purchases the goods or services offered under the plaintiff's mark.” *Toro Co. v. ToroHead Inc.*, 61 U.S.P.Q.2d 1164, 1181 (T.T.A.B. 2001). Apple has been using the IPOD mark continuously for almost ten years, 250 million units have been sold with the IPOD mark prominently displayed, and there are countless other third party products displaying the MADE FOR IPOD Logo.¹⁰⁹ The level of consumer recognition attained by the IPOD mark is truly remarkable. As shown above, Apple also has achieved extraordinary net sales revenues from the IPOD media player: \$143 million in 2002, its first full fiscal year, and over \$4 billion for every year since 2004.¹¹⁰ These numbers leave no doubt as to the overwhelming fame of Apple's IPOD mark.¹¹¹

¹⁰⁶ See *supra* Part IV(A)(4).

¹⁰⁷ *Id.*

¹⁰⁸ See *supra* Part IV(A)(4)(c)

¹⁰⁹ See *supra* Parts (IV)(A)(3) and (8).

¹¹⁰ See *supra* Part IV(A)(1).

¹¹¹ Notably, Opposer's profits, advertising expenditures and duration of use rival and/or surpass those for other marks that have been held famous under these criteria. See, e.g., *Bose Corp.*, 63 U.S.P.Q.2d at

Further, at the time Applicant filed its application, Apple had been using the IPOD mark continuously for nearly a year and a half in connection with the tremendously successful IPOD media player.¹¹² As shown above, Apple had invested millions of dollars in advertising and enjoyed millions of dollars in sales well before Applicant filed its application,¹¹³ and had received tremendous favorable media attention as well.¹¹⁴ The significant level of national and international fame associated with Apple's IPOD marks was established well before the filing of Applicant's intent-to-use application for the VIDEO POD mark. Indeed, Applicant itself admits that it was familiar with the IPOD media player and mark when it filed the application for VIDEO POD.¹¹⁵

d) Third-Party Recognition of the Fame of Apple's IPOD Mark

As a result of its considerable fame,¹¹⁶ Apple itself has received an extraordinary amount of unsolicited media attention, and much of this attention has focused on the IPOD marks exclusively.¹¹⁷ *See, e.g., Starbucks U.S. Brands LLC v. Ruben*, 78 U.S.P.Q.2d 1741, 1751 (T.T.A.B. 2006) (extensive

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1306, 1309 (\$50 million in annual sales of ACOUSTIC WAVE mark, more than \$5 million in annual advertising); *Kenner Parker Toys*, 22 U.S.P.Q.2d at 1454-55 (\$30 million of PLAY-DOH sales and \$2 million in advertising expenditures in 1988); *Nina Ricci*, 12 U.S.P.Q.2d at 1902 (\$200 million in sales of NINA RICCI products with \$37 million in advertising); *Kimberly-Clark Corp. v. H. Douglas Enters., Ltd.*, 227 U.S.P.Q. 541, 542 (Fed. Cir. 1985) (\$300 million in sales of HUGGIES diapers over 9 years; \$15 million in advertising in one year).

¹¹² La Perle Depo. 41:6-23, Ex. 8; Opposer's Not. of Rel. 1, Ex. 1, at 2, and Ex. 14.

¹¹³ *See supra* Parts IV(A)(1) and (4).

¹¹⁴ *See supra* Part IV(A)(5).

¹¹⁵ Kokin Depo. 5:17-6:4, 28:24-29:1; Opposer's Not. of Rel. 1, Exs. 205 and 206 at 2.

¹¹⁶ The Board recently recognized when sustaining Apple's opposition to another confusingly similar mark, "both the APPLE word mark and the APPLE design logo are famous marks in connection with at least the software and computer-related services as pleaded by opposer in this proceeding." *Apple, Inc. v. Echospin, LLC*, Opposition No. 91171592, 2010 WL 2783894, at *7 (T.T.A.B. June 29, 2010).

¹¹⁷ *See supra* Part IV(A)(5).

media coverage is indicative of fame); *Bose Corp.*, 63 U.S.P.Q.2d at 1309 (same). Even Applicant itself concedes that the IPOD mark is famous.¹¹⁸

e) Applicant's Intent in Selecting the VIDEO POD Mark

In light of the overwhelming amount of coverage of the IPOD mark and product, there is no doubt that the IPOD mark was famous at least by February 14, 2003, when Applicant filed its intent-to-use application for registration of VIDEO POD. Applicant's adoption of the VIDEO POD mark for projectors for use with portable devices, when it was already well aware of Apple's famous IPOD mark and product, suggests the very type of free-riding on Apple's hard-earned good will that the Lanham Act was designed to prevent. The evidence plainly shows Applicant not only selected the VIDEO POD mark to trade on the fame of the IPOD mark and product, but also made other intentional efforts to associate its company and its products with Apple and the IPOD product, *even going so far as to display an IPOD media player on Applicant's website.*¹¹⁹

f) The Conceptual Strength of Apple's Marks

Finally, Apple's IPOD mark is a conceptually strong mark deserving of broad protection. Apple's IPOD mark is a coined, fanciful mark with no meaning as applied to Apple's goods and services. Indeed, Applicant *admits* that the POD component of Apple's mark has no descriptive meaning as applied to Apple's IPOD product (in marked contrast to the descriptive nature of the term POD in relation to Applicant's pod-shaped video player).¹²⁰ For this additional reason, Apple's IPOD mark is entitled to broad protection. Fanciful marks are inherently distinctive and given a broad scope of protection. *See, e.g., Stork Rest. v. Sahati*, 76 U.S.P.Q. 374 (9th Cir. 1948); 2 McCarthy § 11:6 ("Fanciful marks as

¹¹⁸ Opposer's Not. of Rel. 1, Ex. 205 at 6 and Ex. 206 at 5. (RFA No. 19 and RFA No. 29).

¹¹⁹ *See supra* Part IV(C); Opposer's Not. of Rel.1, Ex.196, 198 ("I think you should also study the Xbox colors, Apple, Sony and Nintendo so that it color coordinates with their products. By doing this, you become an accessory with their products.") Kokin Depo. 42:20 to 43:16, 44:3-11, and Ex. E.

¹²⁰ *See* Opposer's Not. of Rel. 1, Ex. 205, and 206 (RFA 16); Kokin Depo. 67:25-68:7. *See also* La Perle Depo. 40:23-41:5.

inherently strong trademarks.”). Further, Apple has made consistent efforts to protect the exclusivity of its IPOD mark, and nothing in the record suggests that Apple does not enjoy exclusive use of its IPOD mark with the relevant goods and services, or in general. Indeed, the only evidence in the record is that Apple has exclusive rights to IPOD in International Class 9.¹²¹

In view of all the evidence cited herein, the overwhelming commercial and conceptual strength of Apple’s IPOD mark cannot be disputed, and weighs heavily in favor of a finding of a likelihood of confusion. “*A strong mark . . . casts a long shadow which competitors must avoid. . . . As a mark’s fame increases, the [Lanham] Act’s tolerance for similarities in competing marks falls.*” *Kenner Parker Toys*, 22 U.S.P.Q.2d at 1456 (emphasis added) (internal citation omitted).

2. The Parties’ Respective Goods Are Virtually Identical and Overlapping

The goods identified in Applicant’s VIDEO POD application are overlapping with or highly related to the goods and services offered by Apple and its licensees under the IPOD mark. The overlap is clear when the language in Applicant’s application is compared with that found in some of Apple’s existing registrations for its IPOD mark. *Hewlett-Packard Co. v. Packard Press, Inc.*, 62 U.S.P.Q.2d 1001, 1004 (Fed. Cir. 2002) (“This ‘relatedness of the goods’ factor compares the goods and services in the applicant’s application with the goods and services in the opposer’s registration.”) (citation omitted).

Ultimately, Applicant seeks to use the VIDEO POD mark in connection with goods that are virtually indistinguishable and inseparable from many goods long offered under Apple’s IPOD mark.¹²² Applicant seeks registration of its VIDEO POD mark for “Video projectors using an optical means to reproduce moving picture signals on a remote surface, for business and entertainment purposes.”¹²³ These goods are included in the goods covered by Apple’s prior registrations, including, without

¹²¹ Opposer’s Not. of Rel. 1, Ex. 213; La Perle Depo. 66:8-67:4, Ex. 23.

¹²² See *supra* Part IV(C).

¹²³ VIDEO POD App. File.

limitation: Reg. No. 3,341,191 (for, *inter alia*, “video viewers, namely, video monitors for portable and handheld digital electronic devices”), Reg. No. 3,741,470 (for, *inter alia*, “video monitors for portable and handheld digital electronic devices”) and Reg. No. 3,341,286 (for, *inter alia*, “video viewers, namely, video monitors for portable and handheld digital electronic devices”).¹²⁴ Apple also licenses its IPOD mark for use with Applicant’s precise goods, *i.e.*, video projectors.¹²⁵ The identity of the goods with which the parties use their respective marks reduces the degree of similarity between the marks necessary to support a finding of likelihood of confusion. *See, e.g., In re Dixie Rests.*, 41 U.S.P.Q.2d 1531, 1534 (Fed. Cir. 1997) (“If the services are identical, the degree of similarity necessary to support a conclusion of likely confusion declines.”) (internal citation and quotation marks omitted).

The clear relatedness of the parties’ goods is established from other evidence in the record. Many third party trademark owners use the same mark with both video/movie projectors and handheld audio/video players under the same mark.¹²⁶ Further, Apple’s IPOD media player and Applicant’s projectors are compatible devices, which the public is likely to purchase together, increasing the likelihood of consumer confusion. Applicant has admitted that the goods identified in its application are consumer products and related to Apple IPOD products, and in fact, has conceded that they were intended to be used in connection with Apple’s devices including the IPOD media player.¹²⁷

¹²⁴ *Id.*

¹²⁵ La Perle Depo. 58:21-65:11, Exs. 18-22, Opposer’s Not. of Rel. 1, Exs. 138-140.

¹²⁶ Opposer’s Not. of Rel. 1, Exs. 27-45.

¹²⁷ Kokin Depo. 78:5-9; Opposer’s Not. of Rel. 1, Ex. 206, at 3: “The goods/services identified in the VIDEO POD Trademark Application are, can or will be used in connection with the handheld and portable media devices that Apple promotes under the IPOD Mark...” (RFA Nos. 17 and 18). Applicant has admitted that Apple uses the IPOD mark for portable and handheld media devices used for both entertainment and business purposes, and that the products are related. (RFA Nos. 4, 5, 9, 10 and 23).

3. The Channels of Trade at Issue Are Identical

In this case there is an automatic presumption that the parties' channels of trade are, or will be, identical. *See, e.g., Starbucks U.S. Brands*, 78 U.S.P.Q.2d at 1751 ("Because the parties' respective application and registrations are unrestricted, and applicant's goods and services are identical to some of opposer's goods and services, we must presume that . . . the parties' respective goods and services will be traveling through the same channels of trade to the same class of consumers.") (citation omitted); *Hewlett-Packard*, 62 U.S.P.Q.2d at 1005. Thus, by their very nature and due to the manner in which they are described in the application, the goods identified in Applicant's application will travel in the same channels of trade as Apple's goods and services, to the same class of consumers. This factor therefore also weighs strongly in favor of a finding of likelihood of confusion.

In any event, no presumption is required as Applicant has admitted that its product was intended for sale in "traditional consumer electronic oriented distribution and retail channels."¹²⁸ The evidence shows Applicant was hoping to sell its VIDEO POD product in some of the very same retail stores that carry Apple's IPOD products, including, for example, Best Buy, Target, Circuit City and Wal-Mart.¹²⁹ As such, there is a high probability that the parties' respective products would be found side-by-side on the same shelf, increasing the likelihood of consumer confusion.

4. The Parties' Marks Are Similar in Appearance, Connotation and Commercial Impression

In the likelihood of confusion analysis, the test for similarity asks whether the marks, when compared in their entireties as to appearance, connotation, and commercial impression, are similar in their overall commercial impressions. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 U.S.P.Q.2d 1689, 1692 (Fed. Cir. 2005); *Starbucks U.S. Brands*, 78 U.S.P.Q.2d at 1752. Similarity is not assessed in a side-by-side comparison, rather, the concern is whether the overall

¹²⁸ Opposer's Not. of Rel. 1, Exs. 208-209, Interrog. No. 4.

¹²⁹ Opposer's Not. of Rel. 1, Exs. 194, 195 at 5; Kokin Depo. 40:17-41:13.

commercial impression created by each mark is likely to lead to consumer confusion in the marketplace. *See, e.g., Carl Karcher Enters.*, 35 U.S.P.Q.2d at 1130; *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 196 U.S.P.Q. 1, 3 (C.C.P.A. 1977). Under this standard, it is unquestionable that VIDEO POD is highly similar to both IPOD and POD, particularly when the descriptiveness of the first component of Applicant's mark, VIDEO, is considered. As discussed above, the VIDEO POD mark incorporates the entirety of Apple's registered POD mark, as well as the prominent component of Apple's famous IPOD mark.

Moreover, the fame of the IPOD mark, as well as the overlap in the parties' goods, are critical factors in the likelihood of confusion analysis here, which should be weighed heavily in the analysis. The extraordinary fame of Apple's IPOD mark is relevant because "[a]s the fame of a mark increases, the degree of similarity between the marks necessary to support a conclusion of likely confusion declines." *Starbucks U.S. Brands*, 78 U.S.P.Q.2d at 1750 (citation omitted). Also pertinent is the identity of many of the goods offered by Apple and Applicant under the marks at issue: "when marks appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Id.* at 1752 (quoting *Century 21 Real Estate Corp. v. Century Life of Am.*, 23 U.S.P.Q.2d 1698, 1701 (Fed. Cir. 1992)) (quotation marks omitted).

Even without this reduced standard, however, the similarities between the VIDEO POD mark and Apple's IPOD and POD marks are striking. The VIDEO POD mark incorporates in its entirety the most prominent element of Apple's famous, coined, and registered IPOD mark. In addition, the dominant element of Applicant's mark, POD, is identical to the POD slang term used to refer to the IPOD products, as well as the same mark for which Apple owns a trademark registration. Apple's IPOD is a coined mark that has achieved undeniable fame, and Applicant's addition of the descriptive term VIDEO does not alter the commercial impression of the mark in the context of the goods identified in Applicant's intent-to-use application. Thus, Applicant's VIDEO POD mark has the same connotation and creates an identical commercial impression as Apple's marks.

Because the VIDEO POD mark incorporates a most prominent component of Apple's famous IPOD mark (and the entirety of Apple's POD mark), the similarities between the VIDEO POD mark and Apple's IPOD and POD marks—particularly when viewed in light of the fame of Apple's IPOD mark and the identity of the parties' goods—are more than sufficient to establish a likelihood of confusion. Indeed, in light of the overwhelming fame of Apple's IPOD mark in connection with handheld and portable digital devices and accessories therefore, it is almost certain that consumers will associate the VIDEO POD mark with Apple and its marks. To prevent such inevitable "free-riding," as well as consumer confusion as to source of affiliation, Applicant's application for VIDEO POD should be denied.¹³⁰

C. Additionally, Applicant's Mark is Merely Descriptive of its Goods and Therefore Unregistrable Under Section 2(e) of the Trademark Act

A mark that merely describes the goods with which it is used is not registrable on the Principal Register absent a showing of secondary meaning. *See* 15 U.S.C. § 1052(e) and (f). A mark is considered merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services. *See In re Thomas Nelson Inc.*, 97 U.S.P.Q.2d 1712, 1715 (T.T.A.B. 2011), citing *In re Gyulay*, 3 U.S.P.Q.2d 1009 (Fed. Cir. 1987) (APPLE PIE held merely descriptive of potpourri); *In re Bed & Breakfast Registry*, 229 U.S.P.Q. 818 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY held merely descriptive of lodging reservations services). The determination of whether a mark is descriptive must be made in relation to the goods with which the mark will be used. *See In re MBNA Am. Bank N.A.*, 67 U.S.P.Q.2d 1778, 1782 (Fed. Cir. 2003); *In re Thomas Nelson Inc.*, 97 U.S.P.Q.2d at 1715. "It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant ingredient, quality,

¹³⁰ As Applicant admits that the VIDEO POD mark is not yet in use, there is no possibility there would be actual confusion. In any event, the operative test under the Lanham Act, of course, is *likelihood* of confusion, not *actual* confusion. 15 U.S.C. § 1052(d).

characteristic, function, feature, purpose or use of the goods or services.” *In re J.R. Simplot Co.*, 2008 WL 853827 (T.T.A.B. Jan. 24, 2008) (not precedential) (citing *In re Gyulay*, 3 U.S.P.Q.2d 1009).

In determining whether a mark is merely descriptive, the Board should evaluate the mark “in its entirety.” *In re Oppedahl & Larson LLP*, 71 U.S.P.Q.2d 1370, 373 F.3d 1171, 1175 (Fed. Cir. 2004) (quoting *Estate of P.D. Beckwith, Inc., v. Comm’r of Patents*, 252 U.S. 538, 40 S.Ct. 414, 64 L.Ed. 705 (1920)). However, this does not mean that “the Board cannot ascertain the meaning of each of the words or components that make up the entire mark. In considering a mark as a whole, the Board may weigh the individual components of the mark to determine the overall impression or the descriptiveness of the mark and its various components.” *In re Oppedahl*, 373 F.3d at 1175.

As the Federal Circuit explained in *In re Oppedahl*, if the component terms of a compound mark are both descriptive, the “PTO must also determine whether the mark as a whole, *i.e.*, the combination of the individual parts, conveys any distinctive source-identifying impression contrary to the descriptiveness of the individual parts.” *Id.* The court continued, “when that mark consists of two descriptive terms, the resulting term will retain its descriptive nature if the combination results in a composite that is itself descriptive.” *Id.*

Here, there is no question that the combination of VIDEO on the one hand and POD on the other results in a combination that is itself descriptive of Applicant’s goods. As summarized above, *supra* at Part IV(D), both “VIDEO” and “POD” are descriptive of Applicant’s claimed video player. Applicant’s mark is merely the combination of these two descriptive terms, and as Applicant freely admits, this combination of “VIDEO” and “POD” remains descriptive of a *pod-shaped video player*. See *supra* Part IV(D).

The Board’s decision in *In re J.R. Simplot Co.* is remarkably on point. There, the Board concluded that the mark PANCAKE PODS was merely descriptive for pod-shaped pancakes. 2008 WL 853827, at *3. Critical to the Board’s decision was its conclusion that the POD component of the applicant’s mark merely described the nature of the goods as “resembling a pod.” *Id.* The Board found

“when combined the terms PANCAKE and PODS do not lose their descriptive significance and, in fact, make clear that applicant’s goods consist of pancakes resembling a pod.” *Id.*

Here, as with PANCAKE PODS, the term VIDEO POD is merely descriptive of Applicant’s pod-shaped video player. Accordingly, VIDEO POD is not entitled to registration on the Principal Register absent a showing of acquired distinctiveness, a showing which Applicant cannot possibly demonstrate since it has not yet commenced use of the VIDEO POD mark in commerce.

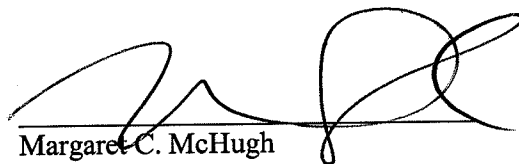
VI. CONCLUSION

The VIDEO POD mark, if registered, would create a likelihood of confusion, mistake, or deception as to the Apple’s IPOD and POD marks, and would injure both Apple and the consuming public, and, accordingly, registration should be refused under Section 1052(d) of the Trademark Act. Further, Applicant seeks to register a mark which it has repeatedly conceded is merely descriptive for a pod-shaped video player. Since Applicant has not commenced use of its mark, it cannot possibly show that the mark has acquired secondary meaning and, accordingly, registration should be refused under Sections 1052(e) and (f) of the Trademark Act.

For these and the reasons expressed above, Apple respectfully requests that this opposition be sustained and the registration of the VIDEO POD mark be refused.

Dated: June 30, 2011

Respectfully submitted,



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CERTIFICATE OF SERVICE

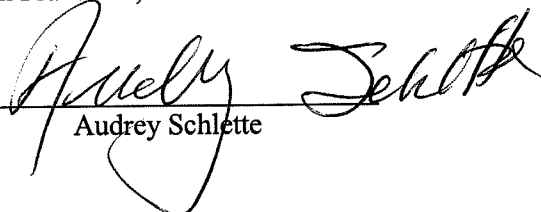
I hereby certify that a true and complete copy of the foregoing **OPPOSER'S TRIAL BRIEF** has been served by mailing said copy on June 30, 2011, via First Class Mail, postage prepaid to:

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Dated: June 30, 2011

By: _____

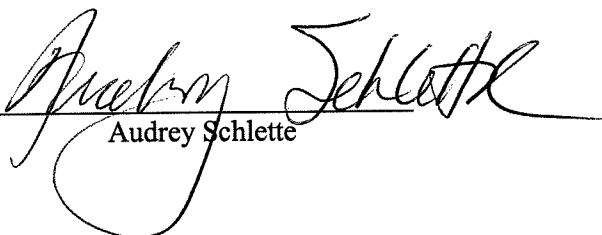

Audrey Schlette

CERTIFICATE OF TRANSMITTAL

I hereby certify that a true and complete copy of the foregoing **OPPOSER'S TRIAL BRIEF** is being filed electronically with the TTAB via ESTTA on this day, June 30, 2011.

Dated: June 30, 2011

By: _____


Audrey Schlette